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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/210,539	12/14/1998	AKIRA ISHIBASHI		5289

7590 04/29/2002

Finnegan, Henderson, Farabow, Garrett & Dunner LLP  
1300 I Street, N.W.  
Washington, DC 20005-3315

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

16

DATE MAILED: 04/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-16

**Office Action Summary**

Application No.

09/210,539

Applicant(s)

ISHIBASHI ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/16/02 has been entered.

### ***Specification***

2. The amendment filed 4/46/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The original disclosure recited "Bionolle" #1020 as being **a talc-containing (30%) grade of the aliphatic polyester** type biodegradable resin made by Showa Highpolymer Co., Ltd. Applicant has now amended the specification to recite that the 30% talc is no longer contained in this grade of aliphatic polyester resin, but **"added"** to the grade of the aliphatic polyester type biodegradable resin in preparing the raw material according to the present invention. This is inconsistent with the original disclosure and the adding of 30% talc to

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to "Bionolle" #1020 in order to obtain the raw materials is not supported by the original disclosure

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 5-8, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 2, 5-8, 10 and 11 recite the limitation "the formed article" in claim 1. There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102/103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 2, 5, 6, 8 and 10-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., for reasons cited in previous Office actions.

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8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., each independently as applied to claims 1, 2, 5, 6, 8 and 10-12 above, and further in view of Yamada et al., for reasons cited in previous Office actions.

***Response to Arguments***

9. Applicant's arguments filed 4/16/02 have been fully considered but they are not persuasive.

10. In response to applicant's arguments that none of the references disclose or suggest a fastening component made from the biodegradable resins, in col. 9, line 32, Obuchi et al. teach that tying material are amount the articles that may be molded form the resin.

Further, in col. 12, lines 17-26, Tsai et al. teaches that the multi-component bio-fibers exhibit good mechanical strength properties such as break properties, such that they maintain their integrity during product use. Tsai et al. also teaches improved moldability and strength over prior biodegradable resins such as solely PLA.

Therefore, it is reasonable that the resin of Tsai et al. would have also been usable in a fastener, since the resin composition is essentially the same as the claimed composition. In re Zierden (162 USPQ 102).

11. As stated in prior actions regarding Applicant's arguments that prior art is silent about the diameter of the dispersed PLA components, the particle diameters claimed by

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applicant would have been within the range of particle diameters for the dispersed PLA of the prior art given that the compositional ranges and the processes used in preparing the prior art articles, which result in the given particle diameters, overlap in scope with that of the present invention. As such, the composition of the prior art is essentially the same as the claimed composition.

12. Again regarding the composition of Bionolle 1020, Applicant refers to an English translation of selected passages of a "TECHNICAL DATA SHEET" which was to be enclosed "herewith". The Examiner has not received said data sheet. It is still asserted the Applicant makes it clear in the original specifications that "Bionolle 1020", the grade of Bionolle presently used, comprises 30% talc. In page 36, lines 17-23 and col. 37, lines 3-7 of the present specifications, Applicant explicitly defines Bionolle 1020 as "commercially available" **"talc-containing (30%) grade of the aliphatic polyester type biodegradable resin made by Showa Highpolymer Co., Ltd and sold under the trademark designation of 'Bionolle' #1020"**. As such, the composition of Tsai et al. is essentially the same as the claimed composition.

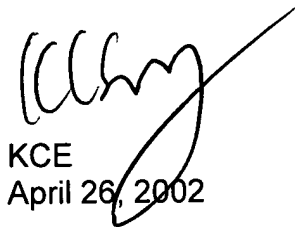
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for

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the organization where this application or proceeding is assigned are 305-3599 for regular communications and 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



KCE  
April 26, 2002